

**REMARKS**

At the time of the Office Action dated March 1, 2006, claims 1-25 were pending and rejected in this application.

**CLAIMS 1-6, 8-9, 11, 13-16, 18-19, 21, AND 23-25 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY LAHIRI ET AL., U.S. PATENT NO. 6,952,664 (HEREINAFTER LAHIRI)**

On pages 2-8 of the Office Action, the Examiner asserted that Lahiri discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.<sup>1</sup> As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.<sup>2</sup> This burden has not been met.

**Claim 1**

On page 3 of the Office Action, the Examiner asserted that "a second one of the test caches, i.e., cache7, has a cache size that is larger than the operational cache." Applicant respectfully disagrees. Claim 1 compares the cache size of a primary cache to the cache sizes of first and second test caches. The size of the segments in the cache simulator 200 of Lahiri,

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<sup>1</sup> In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

<sup>2</sup> Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

however, do not represent actual cache sizes. Instead, as noted by Lahiri, the caches are "simulated." In this regard, the Examiner is directed to column 5, line 64 through column 6, line 3 of Lahiri, which states:

In an illustrative database environment in which a cache simulation system may be operated, the operational buffer cache may be two gigabytes in size and capable of storing one million buffers, with each buffer being approximate two kilobytes. Cache simulator 200 in this environment would then be approximately forty megabytes in size if each simulated buffer in the cache simulator is twenty bytes in size.

Lahiri, therefore, describes the operational buffer as having a 2 gigabyte size, whereas the cache simulator, which contains each of the segments, only has a size of 40 megabytes. Thus, because the caches are "simulated" using the segments, certain of the segments (although possibly having a simulated size twice that of the operational cache) do not have, in actuality, a size greater than the size of operational cache. As noted above, a rejection under 35 U.S.C. § 102 requires the identical disclosure of each of the claimed elements. The Examiner, however, has failed to establish that Lahiri identically discloses that "a second one of said test caches having a cache size which is greater than said size of said primary cache."

#### Claims 6 and 16

With regard to claim 6, in the paragraph spanning pages 4 and 5 of the Office Action, the Examiner asserted:

It is very well known in the art that management of a cache includes inserting, retrieving and evicting cacheable objects and corresponding keys. The operation cache of Lahiri et al. operates in this manner, as evidenced by hit and miss rates kept for the operational cache. Also, Lahiri et al. teaches insertion, retrieving and evicting from the simulated cache, which is made to simulate the operational cache. Therefore, this limitation is at least inherently, if not expressly, disclosed.

The last sentence of this quote evidences the Examiner's uncertainty about the explicit disclosure of the claimed invention. Notwithstanding that the Examiner has failed to clearly designate the teachings in Lahiri being relied upon the statement of the rejection, as required by 37 C.F.R. §

1.104(c),<sup>3</sup> to establish that Lahiri expressly discloses the claimed limitations, the Examiner has failed to put forth a proper inherency analysis.

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.<sup>4</sup> To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.<sup>5</sup> Furthermore, reference is made to ex parte Schricker,<sup>6</sup> in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where the necessity of "locating cached objects selected for retrieval from the active cache by reference to corresponding ones of said caching key" appears in the prior art. Thus, the Examiner has not established that this limitation is inherently disclosed by Lahiri. In this regard, the Examiner is also referred to

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<sup>3</sup> 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

<sup>4</sup> In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

<sup>5</sup> Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

<sup>6</sup> 56 USPQ2d 1723, 1725 (BPAI 2000).

M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

Therefore, the Examiner has failed to establish that Lahiri, inherently or expressly, discloses all of the limitations recited in claims 6 and 16.

Claims 8 and 18

As previously argued with regard to claim 1, Lahiri fails to disclose a test cache larger than the operation cache.

Claims 11 and 21

Claims 11 and 21 recite "searching at least one test cache for a stored cache key which matches said generated cache key," and the generated cache key is used to search the active cache. On page 6 of the Office Action, the Examiner stated:

We know that the active cache is searched as well as the simulated cache, because hit and miss statistics are kept for both the active cache and the simulated cache, as taught in col. 7, lines 39-41.

The Examiner, however, has failed to establish how this assertion relates to the claimed limitation. The assertion that an active cache and a simulated cache are searched do not necessarily lead to a finding that the test cache is searched for a stored cache key which matches a generated cache key used to search the active cache. In this regard, the Examiner has read into the prior art teachings that are not there and made "logical assertions" that are unwarranted.

Therefore, for the reasons stated above, Applicant respectfully submits that Lahiri fails to anticipate the claimed invention within the meaning of 35 U.S.C. § 102. Thus, Applicant solicits withdrawal of the imposed rejection of claims 1-6, 8-9, 11, 13-16, 18-19, 21, and 23-25 under 35 U.S.C. § 102 for anticipation based upon Lahiri.

**CLAIMS 7, 12, 17, AND 22 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS**

**BASED UPON LAHIRI**

On pages 9 and 10 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lahiri to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 7, 12, 17, and 22 respectively depend from independent claims 6, 11, 16, and 21, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 6, 11, 16, and 21 under 35 U.S.C. § 102 for anticipation based upon Lahiri. Accordingly, even if Lahiri were modified in the manner suggested by the Examiner, the proposed modification would not yield the claimed invention. Applicant, therefore, respectfully submits that the imposed rejection of claims 7, 12, 17, and 22 under 35 U.S.C. § 103 for obviousness based upon Lahiri is not viable and, hence, solicits withdrawal thereof.

**CLAIMS 10 AND 20 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON LAHIRI IN VIEW OF SACHEDINA ET AL., U.S. PATENT PUBLICATION NO. 2003/0204698**

On pages 10 and 11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lahiri in view of Sachedina to arrive at the claimed invention. This rejection is respectfully traversed.

Although Applicant disagrees that the claimed invention is obvious based upon Lahiri in view of Sachedina, to expedite prosecution of the Application, Applicant submits that the

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reference to Sachedina cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(l).

**Application No. 10/759,410 (the present application) and U.S. Patent Publication No. 2003/0204698 (Sachedina) were, at the time the invention was made, commonly owned by International Business Machines Corporation**

Thus, under 35 U.S.C. § 103(c), the reference to Sachedina cannot be considered by the Examiner when determining whether Applicant's invention is obvious under 35 U.S.C. § 103. Therefore, for the reasons stated above, Applicant respectfully submits the imposed rejection of claims 10 and 20 under 35 U.S.C. § 103 for obviousness based upon Lahiri in view of Sachedina is not viable and, hence, solicit withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

/s/ Scott D. Paul

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

CUSTOMER NUMBER 46320